

REMARKS

Claims 4-9 and 11-24 are pending. No new matter has been added by way of the present amendments. For instance, claim 21 has been amended to define the groups Z and  $R^1$  as supported by the present specification at page 15, lines 4-6, page 32, second full paragraph and page 42, first full paragraph. Accordingly, no new matter has been added.

Applicants further submit that no new issues have been raised by way of the present submission which would require additional search and/or consideration on the part of the Examiner. For instance, claim 21 has simply been amended to define groups Z and  $R^1$ . The Examiner has already searched and examined these groups as defined in the specification. Accordingly, correctly defining these terms will not require additional search and/or consideration since the Examiner has already searched and considered these groups.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better condition for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. § 112, second paragraph

The Examiner has rejected claims 3-9, 21 and 22 under 35 U.S.C. § 112, second paragraph for the reasons recited at page 2 of the outstanding Office Action. Applicants note that while the Examiner has included claim 3 in this rejection, claim 3 has been previously cancelled. Correction in this regard is requested. Applicants respectfully traverse this rejection.

The Examiner has pointed out that groups Z and R<sup>1</sup> of formula C-2 are not defined in claim 21. Applicants submit that claim 21 (upon which claims 4-9 and 22 depend) has been amended to correct this issue and define groups Z and R<sup>1</sup>. The definition of Z is supported by page 42, lines 8-9 of the present specification. R<sup>1</sup> of formula C-2 is the same as R<sup>1</sup> of formula C-1, since the compound of formula C-2 is a preferred embodiment within the range of the compound of formula C-1, which defines R<sup>1</sup>. Accordingly, this rejection is moot. Reconsideration and withdrawal thereof are requested.

Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 4, 6-8, 21 and 22 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 in view of Sakai '898.

The Examiner has also rejected claims 12-17, 19, 20, 23 and 24 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 in view of Ohshima '471.

The Examiner has rejected claims 9 and 11 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 (or Fujita '866 in view of Sakai '898) in view of Swank '025.

Lastly, the Examiner has rejected claim 5 and 18 under 35 U.S.C. § 103(a) as being obvious over Fujita '866 (or Fujita '866 in view of Sakai '898) in view of Mifune '321.

Applicants respectfully traverse each of the above rejections.

Independent Claim 21 (and claims 4-9 and 22 depending thereon)

With respect to independent claim 21 (and claims 4-9 and 22 which depend thereon) the Examiner's rejections rely upon the primary reference of Fujita '866 and the secondary reference of Sakai '898. The Examiner has asserted that the declarative evidence previously submitted is not commensurate in scope with the present claims. The Examiner argues that both the inventive examples and the comparative examples utilize a dispersing aid; however, independent claim 21 does not recite a dispersing aid.

Applicants submit that it is unnecessary to recite a dispersing aid in claim 21. All examples, both inventive and comparative, include the dispersing aid. In fact, the

comparative experiment and the invention not only share a dispersing agent in common, they also include the same amounts of the dispersing agent. Therefore, it is possible to accurately assess the effective difference between the comparative experiment and the inventive experiment.

The Examiner also asserts that the comparative results with respect to the cyan dye-forming coupler (Formula C-2) are not commensurate in scope with the present claims. Applicants respectfully disagree with the Examiner in this regard. Even though coupler 41 of Sakai may fall within the preferred embodiment of the present invention, it is still the closest prior art. The comparative showing need not compare the claimed invention with all of the cited prior art, In re Fenn et al., 208 USPQ 470 (CCPA 1981), but only with the closest prior art. In re Holladay, 199 USPQ 516 (CCPA 1978); see also In re Merchant, 197 USPQ 785 (CCPA 1978); see also In re Wood et al., 202 USPQ 171 (CCPA 1979). In the case of chemical compounds, this means only the compound or compounds closest structurally thereto must be tested.

In the present instance, out of all the cyan couplers disclosed in Sakai '898, coupler 41 alone is included within the present formula C-2, while the other couplers of Sakai '898 differ greatly in chemical structure from compounds represented by the present formula C-2. In comparing the present invention with the

combination of precedent arts closest to the present invention, the coupler 41 of Sakai was chosen and the coupler C-3 disclosed in Fujita '866 was used as a comparative coupler. Accordingly, the evidence submitted is fully commensurate in scope with the present claims. Moreover, based upon the unexpected results obtained by the present invention, the Examiner's rejection under 35 USC § 103(a) is overcome. Reconsideration and withdrawal thereof are requested.

Independent Claim 23 (and claims 11-20 and 24 depending thereon)

Regarding independent claim 23 (and claims 11-20 and 24 which depend thereon) the Examiner is not persuaded by the submitted arguments. In particular, the Examiner maintains that Fujita '866 discloses materials having a pH of 6.2. Applicants disagree with the Examiner.

The pH disclosed by Fujita '866 of 6.2 is simply the pH of the emulsion. However, this is not what Applicants are claiming. Present claim 23 requires that the pH of the light-sensitive material have a film pH of from 4.6 to 6.4. The pH of the emulsion is not the same as the film pH of the light-sensitive material. Thus, even though the numerical value of 6.2 may fall within the range of 4.6 to 6.4, it is not the film pH of the light-sensitive material (as claimed), but rather the pH of the emulsion.

Applicants note that Ohshima '471, at column 42, lines 50-56, discloses that the pH of the emulsion (6.2 in Fujita '866) differs from the pH of the photosensitive material as the final product which is defined by the present invention. In Ohshima '471, at column 42, lines 66-68, there is a discussion that the pH of a photosensitive material (iii)<sup>6</sup> is from 5.0 to 6.5. However, the photosensitive materials allowing the attainment of the objects described in Ohshima '471 fall roughly into three categories, and only the photosensitive material (iii) among them has its pH within the range of 5.0 to 6.0. Therefore, without further suggestion, those of skill in the art are not motivated to combine this particular disclosure of Ohshima '471 with that of Fujita '866.

As previously argued, Table 3-2 in Example II-1 of the present specification clearly demonstrates that remarkable effects were produced by combined use of a solid dispersion-form dye represented by formula I and a nonsolid dispersion-form dye represented by formula XI, and further combining therewith an adjustment of the film pH to the range defined by the present invention. Such features are neither suggested nor disclosed by the cited art, whether taken alone or in combination. Thus, the Examiner's rejection is moot.

The Examiner has also asserted that Fujita '866 discloses using a combination of dyes according to formula (XI) and (I) of

the present invention. In particular, the Examiner points to samples 108 and 114 of the Fujita reference. Applicants disagree with the Examiner. Although samples 108 and 114 of Fujita '866 share Compound III-34 in common, this compound is not a compound represented by the present formula XI from the viewpoint of chemical structure. More specifically, Compound III-34 has a fused 1-phenyl-5-pyrazolone ring, while the present formula XI does not contain such a fused ring. Viewed in the light of chemical structure, none of the other samples of Fujita '866 suggest or disclose combinations of dyes represented by the present formulae XI and I.

While one embodiment of the present invention involves combining a non-solid dispersion-dye of formula XI with a solid dispersion-form dye of formula I, this combination is not disclosed by Fujita '866. Indeed, Compounds III-9, III-10, III-32 and III-35 illustrated in Fujita '866 are close to compounds represented by the present formula XI, but each of them is a dye dispersible in a solid form and used as a solid dispersion. In using those dyes, the protons of their enol, carboxyl or sulfonamido groups are in an undissociated state. The fact is the solid dispersions cannot be prepared unless the dyes are insoluble in water.

On the other hand, as defined by claim 23, the present dyes represented by formula XI are used in a non-solid dispersion form.

As can be seen from their chemical formulae, the present dyes have ionized structures, and they are soluble in water. In other words, the present dyes in hydrophilic colloid layers are present in an ionized state (more specifically, in a solution state), and they differ entirely from the compounds of Fujita '866 in the state of presence in hydrophilic colloid layers. The absorption spectra of dyes in a solid state are different from the absorption spectra the dyes show in a solution state. In addition, the diffusibilities of dyes themselves in hydrophilic colloid layers greatly vary according to what a state the dyes are in (even if dyes are non-diffusible in a solid state, they can have great diffusibilities when they are dissolved in water). Therefore, the compounds illustrated in Fujita '866 should be regarded as compounds different from the presently claimed dyes.

Based upon the above, Applicants respectfully submit that the Examiner has failed to present a valid *prima facie* case of obviousness. The cited references, whether taken individually or as a whole, fail to suggest or disclose the presently claimed subject matter. Moreover, even if the Examiner has hypothetically presented a valid *prima facie* case of obviousness, the unexpected results of the present invention compared to the cited art rebut any hypothetical case of obviousness. Also, as discussed above, the unexpected results of the present invention, as outlined in previously submitted arguments and Declarations, is commensurate



in scope with the present claims. Accordingly, the Examiner's rejections are moot. Reconsideration and withdrawal thereof are requested.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Pursuant to 37 C.F.R. 1.17 and 1.136(a), the Applicant respectfully petitions for a three (3) month extension of time for filing a response in connection with the present application. The required extension fee of \$920.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fee required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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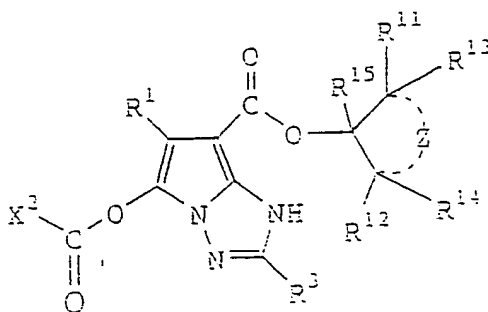
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Attachments: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADEIN THE CLAIMS:

Claim 21 has been amended as follows:

21. (Amended) A silver halide color photographic light-sensitive material for movie, comprising a support having thereon at least one yellow color-forming light-sensitive silver halide emulsion layer, at least one cyan color-forming light-sensitive silver halide emulsion layer, at least one magenta color-forming light-sensitive silver halide emulsion layer, and at least one light-insensitive non-color forming hydrophilic colloid layer, wherein at least one cyan color-forming silver halide emulsion layer contains at least one cyan dye-forming coupler selected from the compounds represented by the following formula [C-2], and at least one light-insensitive non-color forming hydrophilic colloid layer is positioned between the support and a light-sensitive silver halide emulsion layer most adjacent to the support:



[C-2]

wherein  $R^1$  represents an electron attractive group having a Hammett's substituent constant  $\sigma_p$  value of 0.20 or more,  $R^{11}$ ,  $R^{12}$ ,  $R^{13}$ ,  $R^{14}$  and  $R^{15}$ , which may be the same or different, each represents hydrogen atom or a substituent,  $R^3$  represents hydrogen atom or a substituent, Z represents a non-metallic atom group necessary for forming a 5-, 6-, 7- or 8-membered ring, and  $X^2$  represents hydrogen atom or a substituent,

wherein at least one non-color forming hydrophilic colloid layer positioned between said support and a light-sensitive silver halide emulsion layer most adjacent to the support contains a solid fine particle dispersion of a dye represented by formula [I]:



wherein

D represents a compound residue having a chromophore,

X represents a dissociative hydrogen atom or a group having a dissociative hydrogen atom, and

y represents an integer of from 1 to 7.